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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GEREZGIHER, YEMANE M

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/814,522

Applicant(s)

YEN ET AL.

Examiner

Yemane M Gerezgiher

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2144

DETAILED ACTION

1. This application has been examined. Claims 1-27 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-27 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 8, 15, 21 and 27 each recite "registration condition" (See Claim 1, Claim Lines 10-11, Claim 8, Claim Line 6, Claim 15, Claim Line 3, and Lines 7-8, Claim 21, Claim Line 3 and Claim 27, Claim Line 3). It is unclear what the inventive entity meant to encompass by making use of the term "registration condition". The recited limitation ("registration condition") is not clearly defined to indicate whether the "registration condition" is required field in a registration form, or any other condition such as registration fee involved for registration or the limit of user's age at a client system

Art Unit: 2144

to continue to send instructions to the server for registration process. Thus, it is unclear what the inventive entity meant to cover by making use of the phrase "registration condition" which is vague.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Palnitkar et al. (WO 200184359 A2) hereinafter referred to as Palnitkar.

As per claims 1 and 8, sending instructions from said client to said server via a user interface satisfying said registration conditions; (Palnitkar disclosed a client sending a registration request to the central server using a browser (user interface satisfying some registration condition. See Page 16, Lines 9-13, ABSTRACT, Page 21, Lines

Art Unit: 2144

5-12 and Page 24, Line 11 through Page 25, Line 20) sending said corresponding registration web pages from said server to said client and receiving the registration web page form at the client; (Palnitkar taught a central server sending a registration form to the client concerned and receiving the registration page at the client system. See Figure 5, Page 28, Lines 1-22) incorporating a registration record into said registration web pages at said client; (Palnitkar described a client automatically incorporating records in to the registration web page received from the central server at the client side and sending the filled registration forms to the registering server where the server stores the registration record and end the registration process at the server side. See Figures 5, 6, Page 5, Lines 1-19 and Page 20, Lines 1-9).

As per claims 3, and 10, retrieving said registration record from said server to continue said instructions (Palnitkar disclosed a server obtaining a registration record from a database to continue registration process for the requesting user and verifying instructions (claims 2 and 9). See Page 29, Lines 6-15)

Art Unit: 2144

As per claim 15, a server comprising a plurality of registration web pages and a plurality of registration conditions that correspond to said registration web pages (Palnitkar disclosed a server comprising multiple forms requiring data in different formats having therein conditions corresponding to the registration forms used to recognize and populate user records from a database. Palnitkar further disclosed a method and system for facilitating client registration process on the web by avoiding the long and annoying process of filling a registration form. Palnitkar disclosed the system comprising a server having plurality of registration forms and a database containing prerecorded user specific information associated with registration condition, a program in the server extracting and populating the requested form by extracting a user specific information in order to enable user/client to continue sending instructions to the server. See Page 16, Lines 9-13, ABSTRACT, Page 21, Lines 5-12 and Page 24, Line 11 through Page 25, Line 20) and a client that downloads a plurality of registration conditions corresponding to its instructions and determines whether to respond to corresponding registration requests to said server based on said registration conditions (Page 16, Line

Art Unit: 2144

21 through Page 17, Lines 1); wherein said server receives said registration requests and thereafter verifies the completion of registration, said server responding to completion of said registration, indicating the completion of said instructions, said server responding to lack of completion of said registration by sending said registration web pages to said client, whereupon said client incorporating a registration record into said registration web pages, said server responding by continuing to execute said instructions. (Palnitkar disclosed a system where the server receiving an indication indicating if the client has already registered (registration condition), and upon determination of the registration condition, the server automatically recognized and retrieved the registration information and populated the registration according to the condition which resulted in eliminating the burden on the client from filling the registration form multiple times. Palnitkar further taught the server sending registration form for the client to populate consequently when the server did not meet the registration condition. See Page 5, Lines 11-19, Page 6, Lines 5-11, Page 8, Lines 10-23 Page 10, Lines 10-17 and Page 12, Lines 5-22).

Art Unit: 2144

As per claim 21, a server comprising a plurality of registration web pages and a plurality of registration conditions that correspond to said registration web pages; (Palnitkar disclosed a server comprising multiple forms requiring data in different formats having therein conditions corresponding to the registration forms used to recognize and populate user records from a database. Palnitkar further disclosed a method and system for facilitating client registration process on the web by avoiding the long and annoying process of filling a registration form. Palnitkar disclosed the system comprising a server having plurality of registration forms and a database containing prerecorded user specific information associated with registration condition, a program in the server extracting and populating the requested form by extracting a user specific information in order to enable user/client to continue sending instructions to the server. See ABSTRACT, Page 21, Lines 5-12 and Page 24, Line 11 through Page 25, Line 20) and a client, wherein said client continues to send instructions to said server; wherein if said instructions issued by said client satisfy said registration conditions preset by the client, then an inquiry is sent to said client to ask whether said client

Art Unit: 2144

completed said registration, said client responding to said server with yes or no, said server responding to yes from said client by continuing to execute said instructions, said server responding to no from said client by sending said registration web pages to said client, said client receiving said registration web pages, incorporating a registration record into said registration web pages, and returning said registration web pages to said server as instructions to be executed by said server. (Palnitkar disclosed a system where the server receiving an indication indicating if the client has already registered (registration condition), and upon determination of the registration condition, the server automatically recognized and retrieved the registration information and populated the registration according to the condition which resulted in eliminating the burden on the client from filling the registration form multiple times. Palnitkar further taught the server sending registration form for the client to populate consequently when the server did not meet the registration condition. See Page 5, Lines 11-19, Page 6, Lines 5-11, Page 8, Lines 10-23 Page 10, Lines 10-17 and Page 12, Lines 5-22).

As per claim 27, a plurality of registration web pages; a plurality of registration conditions that correspond to

Art Unit: 2144

said registration web pages; (Palnitkar disclosed a server comprising multiple forms requiring data in different formats having therein conditions corresponding to the registration forms used to recognize and populate user records from a database. Palnitkar further disclosed a method and system for facilitating client registration process on the web by avoiding the long and annoying process of filling a registration form. Palnitkar disclosed the system comprising a server having plurality of registration forms and a database containing prerecorded user specific information associated with registration condition, a program in the server extracting and populating the requested form by extracting a user specific information in order to enable user/client to continue sending instructions to the server. See ABSTRACT, Page 21, Lines 5-12 and Page 24, Line 11 through Page 25, Line 20) and an interface that receives instructions from a client, said server responsive to said instructions from said client to determine whether said instructions satisfy said registration conditions, said server responsive to said instructions satisfying said registration conditions to send an inquiry to said client to ask whether said client completed said registration, (Palnitkar disclosed an interface allowing interaction

Art Unit: 2144

between the client system and the server system in the registration process. See Page 4, Lines 15-20 and Page 11, Lines 14-22) said server responsive to a reply of yes received from said client to continue to execute said instructions, said server responsive to a reply of no from said client to send said registration web pages to said client, said server receiving said registration web pages from said client with a registration record incorporated therein, said server executing instructions in response to said registration web pages with said registration record therein. (Palnitkar disclosed a system where the server receiving an indication indicating if the client has already registered (registration condition), and upon determination of the registration condition, the server automatically recognized and retrieved the registration information and populated the registration according to the condition which resulted in eliminating the burden on the client from filling the registration form multiple times. Palnitkar further taught the server sending registration form for the client to populate consequently when the server did not meet the registration condition. See Page 5, Lines 11-19, Page 6, Lines 5-11, Page 8, Lines 10-23 Page 10, Lines 10-17 and Page 12, Lines 5-22).

Art Unit: 2144

As per claims 4, 11, 16, 17, 22 and 23, wherein said user interface is a browser interface for sending said instructions. (Palnitkar disclosed a user interface/browser used to send instructions from the client side to the server side. See Figure 3, Figure 5, Page 28, Lines 12-18, Page 11, Lines 14-17 and Page 13, Lines 13-21)

As per claims 5, 12, 18 and 24, wherein said user interface is provided by said server. (Palnitkar disclosed a central server providing an interface upon registration. See Page 14, Lines 6-14).

As per claims 6, 13 and 25, wherein said instructions to be issued by the client are preset by the server. (Palnitkar disclosed a browser interface having therein preset instructions to be made by the client where each button is set to send an instruction to the server. See Figure 5 and Page 20, Lines 1-9).

As per claims 7, 14, 20 and 26, wherein said instructions sent by said client are executed by clicking a computer mouse, or other input facility. (Palnitkar disclosed a mouse input device enabling a user to interact with the web registration process. See Page 28, Lines 12-18 and Figure 5).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

a. Bunney, William et al. (US 6697792 B2) "Method for distributing information"

b. GABBER, E et al. (US 5961593 A) "System and method for providing anonymous personalized browsing by a proxy system in a network"

c. BYRN, M et al. (WO 200052900 A) "Registration management method involves submitting users registration information that is compiled based on stored registration data of websites, personal data of user, to the website requested by user"

d. Hunt, John F. W. et al. (US 6496855 B1) "Web site registration proxy system"

e. Wright, Robert P. et al. (US 20020016910 A1) "Method for secure distribution of documents over electronic networks"

f. Inala, S K et al. (WO 200180067 A) "Software application for providing proxy auto-registration services to Internet sites, has functions to submit

Art Unit: 2144

specific data, associated with captured site and with requesting user, to sponsoring host"


g. Fukuda, Toshihiro (JP 2001282841 A) "Data search in client-server network, involves registering search condition onto registration form based on which equivalent data from server is searched"

h. Klug, John R. et al. (US 5790785 A) "World Wide Web registration information processing system"

7. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Yemane Gerezgiher whose telephone number is 703-305-4874 or (571) 272-3927 effective October 25th 2004. The examiner can normally be reached on Monday- Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful. The examiner's supervisor, William Cuchlinski, can be reached at (703) 308-3873 or (571) 272-3925 effective October 25th 2004.

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